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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,955	12/28/2001	Brian Stanley Modrzejewski	10541/821	5281
29074	7590	01/07/2004	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60611			LERNER, AVRAHAM H	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/040,955	MODRZEJEWSKI ET AL.
Examiner	Art Unit	J
Avraham Lerner	3611	

-- The MAILING DATE of this communication app ars on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 29 September 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-25 is/are pending in the application.  
4a) Of the above claim(s) 16-25 is/are withdrawn from consideration.

5)  Claim(s) 13 is/are allowed.

6)  Claim(s) 1-6, 14 and 15 is/are rejected.

7)  Claim(s) 7-12 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 01 March 2002 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,9 . 6)  Other: \_\_\_\_ .

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of group I, claims 1-15 in Paper No. 10 is acknowledged. The traversal is on the grounds that it is possible to search the claims of groups I and III together "due to the fact that the claimed system cannot be produced by a materially different product." This is not found persuasive because the claims were restricted as being distinct combination and subcombination groups, specifically because the combination does not require the particulars of the subcombination (limitations of the cam ring as recited in detail, e.g. pivotably supported in the inner cavity by a pivot pin), and the subcombination has separate utility. Additionally, regarding the restriction of the method claims, applicant argues that the method of claims 16-22 would result in the apparatus claimed in claims 1-15. However, it is noted that one-way distinction is required, and the method includes steps not required by the apparatus claims, specifically both providing a cam ring as recited in detail, and transmitting measurements from a control module to an actuator.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means"

and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because the first sentence should not begin "The present invention provides...". Correction is required. See MPEP § 608.01(b).

#### *Claim Objections*

4. Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 14 is identical to claim 2, and therefore should be amended or canceled.

#### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-6 and 14-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Zagranski et al. (U.S. Patent No. 6,623,250).

Zagranski discloses a pump comprising all elements as claimed, including a body having an outer ring defining an inner cavity, wherein the inner cavity further defines a pump suction path and a pump discharge path in fluid communication with the inner cavity; a cam ring (40)

pivots supported in the inner cavity by a pivot pin; an actuated cam formed on the cam ring; an actuator linked to the cam ring for moving the cam ring in a pivotable motion; and a control module (see, for example, column 4 lines 47-53) linked to the actuator. Note that regarding the intended use functional language limitations of the control module, it has been held that the recitation that an element is "adapted to" or "configured to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

***Allowable Subject Matter***

7. Claim 13 is allowed.
8. Claims 7-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Semba (U.S. Patent No. 5,562,432), Oba et al. (U.S. Patent No. 6,530,752), Watanabe et al. (U.S. Patent No. 6,616,419), Konishi (U.S. Patent No. 6,619,928), and Kazuyoshi (U.S. Patent No. 6,155,797) disclose variable displacement pumps having cam rings as claimed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avraham Lerner whose telephone number is (703) 308-0423. The examiner can normally be reached on M-F (8:15-5:45) first Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

**AVRAHAM LERNER**  
**PRIMARY EXAMINER**  
*A. lerner 12/29/03*

December 29, 2003